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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,361	02/16/2000	John M. Packes JR.	99-025	6202

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EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/505,361

Applicant(s)

PACKES ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 12-15, 21-27 and 29-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 12-15, 21-28 and 34-40 set forth method steps which do not result in a useful and tangible result. Simply identifying potential rebate(s) and making an offer to redeem a rebate does not accomplish a useful and tangible result. These method steps are merely preparatory, falling short of issuing the user with a rebate (certificate) or performing the redemption (transfer of value) to the user. Applicant should include the useful and tangible steps of rebate issuance or redemption to avoid such a rejection.

Claims 29-33 merely set forth disembodied data structures. Although the fields are related, there is no useful and tangible structure set forth. The claims provide simply a data file in which no functional change(s) occur when an application uses the data. Such a collection of data is not statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

■ Claim 1 line 4, it is unclear what offer a second rebate "in exchange for the first rebate" includes. Rebates are taken to be merely opportunities which cannot be "exchanged" per se. Applicant should set forth either a) a positive step of agreeing not to redeem the first rebate or b) positively performing an action which prevents the redemption of the first rebate. Such are examples that more clearly define an "exchange".

■ Claim 28 is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the required customer redemption.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 17 as best understood as well as claim 34, are rejected under 35 U.S.C. 102(b) as being anticipated by Buffalo News (Rebate limits can be a pain for consumers, 1/5/1999).

Regarding claims 1, 4-6, Buffalo News teaches that several rebates/promotions can be associated with the same product. A customer may make the qualifying product purchase and be offered multiple rebate opportunities, including rebate(s) from a manufacturer and rebate(s) from the retailer. The customer is free to pursue certain rebates while declining pursuit of others. Regarding claims 5 and 17, Receiving the customer's submitted mail in rebate provides receipt of the customer's acceptance of the rebate and commitment to comply. The rebate value amount provides a "price reduction".

Regarding claims 2, 3, the words "term" and "condition" are both taken to require a "stipulation" associated with the rebate and no distinction is required between the two words. Both the retail and manufacturer rebates require purchase of the qualifying product; this stipulation is taken to provide a condition and/or term of the rebate. Similarly, the value of the rebates are both inherently associated with and based on the value of the original product.

Regarding claim 16, Buffalo News teaches rules and deadlines that are determined for the rebate(s); such reads on "terms and conditions".

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-10, 29-33, 35 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buffalo News in view of Mori (US5200889). Mori discloses awarding/redeeming instant rebates at the Point of Sale (POS). It would have been obvious to one of ordinary skill at the time of the invention to have awarded/redeemed the qualifying manufacturer and retailer rebates taught by Buffalo News at the POS. Mori also teaches accruing qualifying rebate value and redeeming portions or all of such value during a subsequent POS transaction. It would have been obvious to one of ordinary skill at the time of the invention to have collected such value and redeemed it at a second POS terminal, for convenience. The account which accumulates credit in the system of Mori is taken to be a retailer card account.

Regarding claims 29-33, Mori's system includes a database structure including fields for product, customer and rebates [figs 6-10]. It would have been obvious to one of ordinary skill at the time of the invention to have included tables with fields for identifying plural rebates (POS and manufacturer) and their conditions/parameters that the customer may be eligible for, so as to enable offers for multiple rebates. Mori provides customer contact information. Any of the customer fields, especially the numeric ones can be taken to provide customer "statistics".

7. Claims 14, 15, 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buffalo News in view of LA Times ("Loyalty: Check it out" 7/8/1994). LA Times teaches defining customer deals for customers based on frequency of shopping, or characteristics of shopping. It would have been obvious to one of ordinary skill at the

time of the invention to have based the rebate promotion values on characteristics of the customer, as taught by LA Times.

Regarding claim 21, identification of the customer making the transaction is used as a basis for determining the promotional value, and is taken to be "information about a purchase transaction".

Regarding claims 22 and 26, it would have been obvious to one of ordinary skill at the time of the invention to classify a customer who returns as a frequent shopper, and it would have been obvious to one of ordinary skill at the time of the invention to have provided higher frequent-shopper benefits to such a customer.

Regarding claims 23, 24, 27, LA Times teaches "deadlines" for rebates, which is taken as an expiration deadline whereby the rebate value is "zero". Rebate value decreases to a value of zero for all redemption times past the deadline.

Regarding claims 25 and 27, a customer who does not make frequent purchases (over time) will not be classified as a frequent shopper and will not be eligible for such frequent-shopper promotional values.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buffalo News and Mori in view of LA Times ("Loyalty: Check it out" 7/8/1994). LA Times teaches defining customer deals for customers based on their frequency of shopping, or characteristics of shopping. It is also well known to award a customer with a coupon/promotion that requires purchase of a specific product. It would have been obvious to one of ordinary skill at the time of the invention to have required the

customer to purchase a particular product specified by the awarded coupon/promotion for participation, and modified the redeemed value based on the customer characteristics as taught by LA Times.

9. Claims 12, 13, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buffalo News in view of Chew (US5901303). Chew teaches to dynamically change promotion values, depending on product sales/usage [col 7 lines 25-35]. It would have been obvious to one of ordinary skill at the time of the invention to have changed the value of the rebates based on such manufacturer information such as sales or redemption of the current promotion campaign, so that the promotion campaign can be altered to stimulate additional sales/redemptions if the campaign was not meeting expectations.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buffalo News. Official Notice is taken that it is well known to award an eligible customer of a promotion with a coupon to be used during a future transaction. It would have been obvious to one of ordinary skill at the time of the invention to have awarded customers with such a coupon so that they may enjoy a discount or free product as a condition of returning to the store, thus stimulating return visits and additional purchases.

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buffalo News in view of West et al (US5845259). West et al teaches to reimburse a retailer for



rebates/promotions which are rewarded by the retailer [col 8 lines 40-45] It would have been obvious to one of ordinary skill at the time of the invention to have determined and disbursed an amount for the retailer who has provided in-store discounts/promotions.

### ***Allowable Subject Matter***

12. Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nets season ticket holder rebate, 12/8/1976, The New York Times, Col 5 pg 12, sec 2 teaches offering a 10% rebate now, or a 10% discount on a future purchase.
- Aylward, Larry, "What's the Forecast?", 7/1/1993, Aftermarket Business, p12 teaches providing a customer with the choice of receiving a rebate or donating the rebate to a charity.
- "Storage: Epson extends Zip rebate program for holiday shoppers", 10/7/1996, EDGE Publishing, EDGE: Work-Group Computing Report teaches providing customers with a rebate choice between \$50 cash or \$60 worth of zip disks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc  
September 9, 2002